



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,063	07/26/2000	Louri Brylov	10001122.1	8584

22879 7590 02/18/2005

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,063

Applicant(s)

BRYLOV, LOURI

Examiner

CHAN S PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/6/04 has been entered.

Response to Amendment

2. Applicant's amendment was received on 12/6/04, and has been entered and made of record. Currently, **claims 49-71** are pending.

Response to Arguments

3. Applicant's arguments with respect to claims 49-71 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claim 65 is objected to because of the following informalities: Perhaps claim should be amended as "... wherein said scanner is directly connects connected to a local server ...". Appropriate correction is required.

Art Unit: 2622

5. Claim 66 is objected to because of the following informalities: Perhaps claim should be amended as "... a plurality of different preset destination locations ...".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 49 and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant claims that the drag and drop operation is processed using a user interface on said standalone scanner. Referring to the applicant's original disclosure with respect fig. 3B, wherein on page 7, lines 1-14, it is not clearly disclosed as to what kind of an input device, which is apparently an internal part of the standalone scanner according to the claim, performs this drag and drop function. In other words, it is unclear as to what part of said standalone scanner is the user interface and how this user interface performs the drag and drop operation. Additionally, Examiner respectfully requests the applicant to show where in fig. 3B exactly shows the user interface in the standalone scanner.

Art Unit: 2622

7. Claim 69 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Referring to the applicant's original disclosure with respect fig. 3B, wherein on page 7, lines 1-14, it is not clearly disclosed as to whether a mouse is a part of the standalone scanner. Further, even if the applicant's original Specification has a support for this limitation, it is questionable as to how a mouse can be physically incorporated into or located in a standalone scanner. Examiner finds no support for such a disclosure in the original Specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 49-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "standalone scanner" in claims 49-71 is a relative term which renders the claim indefinite. The term "standalone scanner" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. As set forth above, it is uncertain as to what devices can be included and what devices cannot be included in the standalone scanner. Referring again to fig. 3B,

Art Unit: 2622

the applicant discloses that the keypad 65 and the display 66, which clearly is shown as a monitor, are externally connected to the standalone scanner 16. Also, the applicant acknowledges that the keypad and the display are optional devices. If such optional devices can be a part of the standalone scanner, it is questionable as to if any other optional devices, such as a printer, speaker, floppy disk drive, projector, Ethernet port, PC and/or any other image processors, can be a part of the standalone scanner. Thus, the term "standalone scanner" is vague and indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 49 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by
Reele U.S. Patent No. 6,567,190.

9. With respect to claim 49, Reele teaches a method of transferring an image to a destination, the method comprising:

displaying destination options on a user interface on a standalone scanner (col. 3, line 45 – col. 4, line 17);

obtaining a destination from said user interface, wherein said destination is connected to said standalone scanner using a network (col. 3, line 45 – col. 4, line 17);
scanning an image on said standalone scanner (fig. 3); and
transferring said image to said destination (fig. 3).

10. With respect to claim 53, Reeley teaches the method of claim 49, further comprising automatically converting said image to a different document format before said storing (col. 3, line 51 and fig. 3).

Claim 49 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Han U.S. Patent No. 6,608,707.

11. With respect to claim 49, Han teaches a method of transferring an image to a destination, the method comprising:

displaying destination options on a user interface on a standalone scanner (col. 11, lines 14-15 & col. 12, lines 22-23);

obtaining a destination from said user interface, wherein said destination is connected to said standalone scanner using a network (col. 4, lines 33-45; col. 11, lines 14-15; and col. 12, lines 22-23);

scanning an image on said standalone scanner (col. 11, lines 6-15); and
transferring said image to said destination (col. 11, lines 6-15).

12. With respect to claim 53, Han teaches the method of claim 49, further comprising automatically converting said image to a different document format before said storing (col. 2, lines 5-9 & col. 5, lines 30-54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han as applied to claim 49 above, and further in view of Machida U.S. Patent No. 6,642,943.

13. With respect to claim 50, Han teaches the method of claim 49, but it does not teach expressly that said user interface comprises a browser.

Machida, the same field of endeavor of network image data transfer method, teaches a user interface comprising a browser for selecting a destination (figs. 5 & 11).

Since Han teaches the method of eliminating the need for having a computer operatively connected during the scanning process (col. 3, lines 35-37) by incorporating the PC central processing unit inside the scanner (col. 5, lines 55-60), which further includes a cursor or pointer in the control panel for the movement operation (col. 4, lines 33-34), it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the browser of Machida into the standalone scanner of Han.

The suggestion/motivation for doing so would have been to provide a more user-friendly display setting for the network data communication at the site of the scanner.

Therefore, it would have been obvious to combine Han with Machida to obtain the invention as specified in claim 50.

Art Unit: 2622

14. With respect to claim 51, Han teaches the method of claim 49, but it does not teach expressly that said obtaining said destination comprises detecting a drag and drop operation wherein a first icon is dragged to a location indicator and dropped on said location indicator.

Machida, the same field of endeavor of network image data transfer method, teaches a user interface that supports a drag and drop operation wherein a first icon is dragged to a location indicator and dropped on said location indicator (col. 10, lines 46-50).

Since Han teaches the method of eliminating the need for having a computer operatively connected during the scanning process (col. 3, lines 35-37) by incorporating the PC central processing unit inside the scanner (col. 5, lines 55-60), which further includes a cursor or pointer in the control panel for the movement operation (col. 4, lines 33-34), it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the drag and drop method of Machida into the standalone scanner of Han.

The suggestion/motivation for doing so would have been to provide a more user-friendly display setting for the network data communication at the site of the scanner.

Therefore, it would have been obvious to combine Han with Machida to obtain the invention as specified in claim 51.

15. With respect to claim 52, Machida teaches that the first icon is a scanner icon (col. 10, lines 46-50 and fig. 5).

Art Unit: 2622

Claims 54-58, 60-69 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han in view of Nagasaka et al. U.S. Patent No. 6,556,875 (hereinafter Nagasaka).

16. With respect to claim 54, Han discloses an apparatus for controlling an image scanning process in a standalone scanner, comprising:

- a. at least one computer readable medium; and
- b. computer readable program code stored on said at least one computer readable medium, said computer readable program code being automatically executed on said standalone scanner when a command is given to transfer image data to a destination, said computer readable program code comprising:
 - i. program code for establishing a connection between said standalone scanner and the destination location;
 - ii. program code for causing said standalone scanner to scan at least one image; and
 - iii. program code for transferring said at least one image from said standalone scanner to said destination location.

Han does not disclose expressly the drag and drop operation wherein a first displayed element, which is associated with said scanner, is dragged to and dropped upon a second displayed element, which is associated with said destination.

Nagasaka, the same field of endeavor of network image data transfer apparatus, discloses an apparatus for controlling an image scanning process, comprising:

Art Unit: 2622

- a. at least one computer readable medium (software in col. 3, lines 9-12);
and
- b. computer readable program code stored on said at least one computer readable medium, said computer readable program code being automatically executed when a first displayed element is dragged to and dropped upon a second displayed element (col. 21, lines 5-17; col. 32, lines 20-29; and fig. 7B),
said computer readable program code comprising:
 - i. program code for establishing a connection between a scanner associated with said first displayed element and a destination storage location associated with said second displayed element (col. 20, lines 58-63 and col. 32, lines 20-29);
 - ii. program code for causing said scanner to scan at least one image (col. 26, lines 3-22); and
 - iii. program code for transferring said at least one image from said scanner to said destination storage location and storing said at least one image in said destination storage location (fig. 3A; col. 3, lines 9-27; col. 17, lines 30-37; and col. 22, lines 60-64).

Referring to fig. 3A, Nagasaka teaches that the buffer in device driver 32b can be part of the destination device 41. Additionally, a printer buffer or RAM in a printer is an inherent feature (unless the printer is real-time printer) since the printer has to store to the received print data either permanently or temporarily for rendering.

Furthermore, since the destination device can be either facsimile or electronic mail device (col. 22, lines 60-64), the received data must be stored for further process (displaying the email or transmitting the image).

Since Han teaches the method of eliminating the need for having a computer operatively connected during the scanning process (col. 3, lines 35-37) by incorporating the PC central processing unit inside the scanner (col. 5, lines 55-60), which further includes a cursor or pointer in the control panel for the movement operation (col. 4, lines 33-34), it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the drag and drop method of Nagasaka into the standalone scanner of Han.

The suggestion/motivation for doing so would have been to provide a more user-friendly display setting for the network data communication at the site of the scanner.

Therefore, it would have been obvious to combine Han with Nagasaka to obtain the invention as specified in claim 54.

17. With respect to claim 55, Nagasaka discloses the apparatus, wherein said computer readable program code is executed without further user intervention after said first displayed element is dragged to and dropped upon said second displayed element (col. 22, lines 7-17 and col. 26, lines 3-22). The suggestion/motivation for incorporating this feature into the standalone scanner of Han would have been to automatically perform the transfer without further user intervention after the drag and drop operation.

18. With respect to claim 56, Nagasaka discloses the apparatus, wherein said first displayed element comprises a scanner icon (fig. 7B).

Art Unit: 2622

19. With respect to claim 57, Nagasaka discloses the apparatus, wherein said user interface comprises a browser (fig. 23).

20. With respect to claim 58, Nagasaka discloses the apparatus, said computer readable program code further comprising program code for converting said at least one image to a different document format before said transferring and said storing (col. 19, lines 1-12). The conversion is performed before the data transfer from image processing server D to printer D in fig. 18.

Han discloses the apparatus further comprising automatically converting said image to a different document format before said storing (col. 2, lines 5-9 & col. 5, lines 30-54).

21. With respect to claim 60, Nagasaka discloses the apparatus, said computer readable program code further comprising program code for determining if said destination storage location is a supported location (col. 22, lines 7-17 and col. 26, lines 3-19). The suggestion/motivation for incorporating this feature into the standalone scanner of Han would have been to automatically determine whether the scanned image can be transfer to the destination prior the actual transmission.

22. With respect to claim 61, Han discloses a standalone scanner apparatus, comprising:

means for obtaining a destination location, wherein said destination is connected to said standalone scanner by a network (col. 4, lines 33-45; col. 11, lines 14-15; and col. 12, lines 22-23);

means for automatically causing said standalone scanner to scan at least one image when said destination location is obtained (col. 11, lines 6-15); and

means for automatically transferring said at least one image to said destination location when said scan of said at least one image is complete (col. 11, lines 6-15).

Han does not expressly disclose that the means for obtaining a destination location is from a browser.

Nagasaka, the same field of endeavor of network image data transfer apparatus, discloses an apparatus for controlling an image scanning process, the apparatus comprising:

browser means for obtaining a destination location, wherein said destination is connected to a standalone scanner by a network (fig. 23);

means for automatically causing said standalone scanner to scan at least one image when said destination location is obtained (col. 22, lines 7-17 and col. 26, lines 3-22); and

means for automatically transferring said at least one image to said destination location when said scan of said at least one image is complete (col. 22, lines 7-17 and col. 26, lines 3-22).

Since Han teaches the method of eliminating the need for having a computer operatively connected during the scanning process (col. 3, lines 35-37) by incorporating the PC central processing unit inside the scanner (col. 5, lines 55-60), which further includes a cursor or pointer in the control panel for the movement operation (col. 4, lines

Art Unit: 2622

33-34), it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the browser of Nagasaka into the standalone scanner of Han.

The suggestion/motivation for doing so would have been to provide a more user-friendly display setting for the network data communication at the site of the scanner.

Therefore, it would have been obvious to combine Han with Nagasaka to obtain the invention as specified in claim 61.

23. With respect to claim 62, Han discloses a standalone scanner connected to a network, the standalone scanner comprising:

- a processor (col. 5, lines 55-60);

- a memory coupled to the processor (col. 12, lines 6-27);

- a program stored in the memory for accessing destination locations on the network (col. 12, lines 6-27);

- a display for displaying the destination locations (col. 3, line 45 – col. 4, line 17);

and

- a keypad for entering a destination location on the network and for causing the standalone scanner to scan an image and automatically send the scanned image to the destination location (col. 12, lines 22-23).

With respect to rest of the claim, arguments analogous to those presented for claim 61, are applicable.

24. With respect to claim 63, Nagasaka discloses the apparatus, wherein the destination location is a URL address on the World Wide Web (col. 33, lines 1-12). The

Art Unit: 2622

suggestion/motivation for incorporating this feature into the standalone scanner of Han would have been to provide the destination information using the World Wide Web.

25. With respect to claim 64, Han discloses the apparatus, wherein the network is the Internet (col. 12, line 9 & lines 22-23).

26. With respect to claim 65, Nagasaka discloses the apparatus, wherein said scanner is directly connected to a local server via a communication link for sending the scanned image to the local server and then the destination location (col. 19, lines 4-12). The suggestion/motivation for incorporating this feature into the standalone scanner of Han would have been to provide an image processing server for executing of the enlargement/contraction of the image outside of the standalone scanner.

27. With respect to claim 66, Nagasaka discloses the apparatus further comprising a plurality of different preset destination locations of the network stored in the memory (col. 19, lines 13-30 and fig. 20). The suggestion/motivation for incorporating this feature into the standalone scanner of Han would have been to update the destination information from the server.

28. With respect to claim 67, Nagasaka discloses the apparatus further comprising the preset destination locations are downloaded from the network (col. 13, lines 1-12). The suggestion/motivation for incorporating this feature into the standalone scanner of Han would have been to update the destination information from the server.

29. With respect to claim 68, Nagasaka discloses the apparatus further comprising a network card to establish communication to a remote server on the network (col. 13,

Art Unit: 2622

lines 1-12). Han also discloses the apparatus further comprising a network card to establish communication to a remote server on the network (col. 12, line 8).

30. With respect to claim 69, Han discloses the standalone scanner further comprising a mouse and a keyboard for providing input from a user (col. 4, lines 33-34 & col. 12, line 23).

31. With respect to claim 71, Nagasaka discloses the apparatus wherein the display displays a list of available servers as icons that represent available destination locations on the network (fig. 20). Note that it would have been obvious to one of ordinary skill in the art to represent the configuration of fig. 20 as an icon configuration. It would have been obvious since Nagasaka teaches the benefit of representing the devices as icons in fig. 23. Further, the suggestion/motivation for incorporating this feature into the standalone scanner of Han would have been to provide a more user-friendly display setting for the network data communication at the site of the scanner.

Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Han and Nagasaka as applied to claim 54 above, and further in view of Lamming et al. U.S. Patent No. 5,862,321 (hereinafter Lamming).

32. With respect to claim 34, the combination of Han and Nagasaka discloses the apparatus of claim 54, but it does not disclose expressly that the connection is an FTP connection.

Lamming, the same field of endeavor of scanned image transfer, teaches a network connection using an FTP connection (col. 5, lines 12-16).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the FTP connection of Lamming into the drag-and-drop system of Nagasaka.

The suggestion/motivation for doing so would have been to transfer the scanned image or documents on the Internet.

Therefore, it would have been obvious to combine Han and Nagasaka with Lamming to obtain the invention as specified in claim 59.

Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Han and Nagasaka as applied to claim 62 above, and further in view of Machida.

33. With respect to claim 70, the combination of Han and Nagasaka discloses the apparatus of claim 62 wherein the apparatus has the ADF function (col. 8, line 48 of Han), but it does not teach expressly that the first icon comprises an ADF icon for ADF in said scanner.

Machida, the same field of endeavor of drag-and-drop system, teaches an ADF icon for an ADF in a scanner (col. 28, lines 10-13).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the ADF icon for a ADF in said scanner of Machida into the drag-and-drop system of Nagasaka.

The suggestion/motivation for doing so would have been to inform the user that an ADF is present in the scanner.

Art Unit: 2622

Therefore, it would have been obvious to combine Han and Nagasaka with Machida to obtain the invention as specified in claim 70.

Conclusion


34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
February 9, 2005


EDWARD COLES
SUPERVISORY PATENT EXAMINER
ELECTRONIC BUSINESS CENTER